

REMARKS

This paper is filed in response to the Restriction Requirement set forth in the Office action (Paper No. 20080423) mailed on 25 April 2008. Reconsideration and re-examination are respectfully requested.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), this listing of the claims, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

No claims are amended by this paper.

Status of the Claims

Upon entry of this paper, claims 1 through 37 will be pending.

Requirement for Restriction - 37 CFR §1.142

In the Office action mailed on 25 April 2008 (Paper No. 20080423), the Examiner pursuant to 35 U.S.C. §121 and 37 CFR §1.142 required a restriction between:

- **Group I:** Claims 1-8 and 23-37, drawn to system and method for simultaneous ring service to wired terminals and mobile terminals, classified in class 379, subclass 211.04;
- **Group II:** Claims 9-22, drawn to a wired and wireless interconnecting unit [*sic*, that] changes a caller identification of the call to a virtual wired number with which a wireless terminal is endowed, classified in class

379, subclass 201.01.;

Applicant's Election - 37 CFR §1.142

Applicants respectfully traverse the election requirement imposed in the Office action, but provisionally elect Group I, covered by claims 1-8 and 23-37, drawn to system and method for simultaneous ring service to wired terminals and mobile terminals.

Applicant's Traversal of the Requirement for Restriction - 37 CFR §1.142

Applicant objects to and traverses the restriction requirement on the grounds that the subject matter of the two groups are overlap and must be simultaneously examined in compliance with 37 CFR §1.104(a). In addition, the mandatory fields of search for the two embodiments are coextensive. Finally, it appears that the restriction requirement is being imposed merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

Firstly, the Examiner has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner **must examine the application on the merits**, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office action mailed on 25 April 2008 (Paper No. 20080423) and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in

the next Office action, the restriction requirement cannot be made final according to MPEP §706.07.

Secondly, whereas the Examiner has stated that the invention of Group I including claims 1-8 and 23-37, drawn to system and method for simultaneous ring service to wired terminals and mobile terminals, classified in class 379, subclass 211.04; and Group II including claims 9-22, drawn to a wired and wireless interconnecting unit changes a caller identification of the call to a virtual wired number with which a wireless terminal is endowed, classified in class 379, subclass 201.01, it is submitted that, in order to perform a comprehensive search, the Examiner is going to be compelled to perform some searching in class 379 and both subclasses 211.04 and 201.01.

A search of the U.S. Patent Collection produced the following partial list of recent U.S. Patent issues which are in fact classified in both class 379, and subclasses 211.04 and 201.01:

Results of Search in US Patent Collection db for:

(CCL/379/211.04\$ AND CCL/379/201.01\$): 4 patents.

	<u>PAT. №.</u>	<u>Title</u>
1	7,274,782	Method and apparatus for selectively establishing communication with one of plural devices associated with a single telephone number
2	7,162,020	Method and apparatus for selectively establishing communication with one of plural devices associated with a single telephone number
3	6,728,360	Call processing software, methods and equipment providing enhanced notifications
4	6,011,843	Method and apparatus for initiating parallel connections to identified plural sites

This partial listing of art included within both Groups I and Group II demonstrates both the lack of

burden upon the Examining staff in making a simultaneous search of both Groups I and II and the absence of evidence that Groups I and II are distinct. As specifically stated in MPEP §803, in imposing a restriction requirement, the Examiner must show that:

(A) the inventions are independent (*see* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see* MPEP §806.05 - §806.05(i)); **and**

(B) there will be a **serious burden** on the Examiner if the restriction requirement is not imposed (*see* MPEP §803.02, §806.04(a) -§806.04(i),§808.01(a), and §808.02). It is respectfully submitted that there would **not be a serious burden** upon the Examiner in searching Groups I and II.

It is submitted therefore, that Applicant's foregoing listing of a search of the U.S. Patent Collection produced the above-repeated partial list of recent U.S. Patent publications and U.S. patent issued which are in fact classified in both class 379, subclass 211.04 and 201.01. In point-of-fact, the classification 379/211.04 (... Simultaneous ringing) of elected Group I is a third-level breakout subclass of the subclassification 379/201.04 (***SPECIAL SERVICES***) of non-elected Group I. Consequently, examination of subclass 201.01 is within the mandatory field of search required for examination of elected Group I. There is therefore, no demonstration of a burden.

Thus, under long standing Office practice extending over approximately three decades, the fields of search are coextensive with respect to the two groups of claims, and therefore the restriction requirement serves no purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see* MPEP §802.01, §806.04, §808.01).

Thirdly, MPEP §806.03 states that:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention,

restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? In point-of-fact, there is no constituent component of independent claim 1 drawn to the subject matter of elected Group I which is not also found among claims 9 through 22 of non-elected Group II. That fact, together with the fact that Applicant’s claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant’s inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.


For the above reasons, it is respectfully submitted that the restriction requirement is unnecessary, is not in accordance with the Rules of Practice or the *Manual of Patent Examining Procedure*, and constitutes the imposition of an undue burden and unfair expense upon the Applicants. Therefore, the restriction requirement should be withdrawn.

If the requirement for restriction is not withdrawn, then the Applicants reserve the right to file a Petition to the Commissioner because there is no *serious* burden upon the Examiner in searching the invention of Group I and Group II.

In view of the foregoing demonstration of the impropriety of this requirement, it is requested that the restriction requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No fee is incurred by this response.

Respectfully submitted,



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